

REMARKS

The law firm of Harrington & Smith PC has been requested by the Assignee to assume responsibility for the further prosecution of this patent application. A Revocation of prior powers and an Appointment of new powers will be filed forthwith.

In the Advisory Action the Examiner indicated that the amendments proposed in the response to final rejection would not be entered. The foregoing amendment repeats the previously submitted amendments, and also makes additional amendments as discussed below.

The drawings were objected to under 37 CFR 1.83(a) as allegedly not showing every feature of the invention specified in the claims, in particular, a "processor," as recited in claims 19, 21, and 25. Applicants traverse this objection as legally improper.

37 CFR 1.81 states, "The applicant for a patent is required to furnish a drawing of his invention where necessary for the understanding of the subject matter sought to be patented". 37 CFR 1.83(a) further modifies 37 CFR 1.81 by adding, "The drawing in a nonprovisional application must show every feature of the invention specified in the claims." In other words, only in the case where a drawing is necessary for the understanding of the subject matter sought to be patented, and the drawing has been provided, does an Applicant need to show every claimed feature for the depicted embodiment.

In the present case, although Figures 1-5 have been provided for the Examiner's convenience, new drawings are not necessary, since the drawings clearly illustrate the subject matter sought to be patented. For example, Figure 1 shows proxy call session control function (P-CSCF's) 35 and 37, interrogating call session control function (I-CSCF's) 38 and 39, and a serving call session control function (S-CSCF) 36. One of ordinary skill in the art would recognize that the P-CSCF's, the I-CSCF's, and the SCSCF are typically equipped with a "processor," or as amended in the claims above "a controller" that is configured to perform the claimed

function(s). Thus, Figure 1 illustrates the "processor" or "controller" of the claimed invention. Accordingly, Applicants respectfully submit that this objection is clearly improper and, therefore, should be withdrawn.

Claims 19, 21, and 25 were rejected under 35 USC 112, first paragraph, because the limitation a "processor" is allegedly not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention. In response, and for at least the reasons argued above, it is respectfully requested that the 35 USC 112, first paragraph rejection be withdrawn.

Claims 25, 26, 37, 38, 43 and 45 were rejected under 35 U.S.C. §102(b) as being anticipated by Phan-Anh (WO 02/091785). This rejection is respectfully traversed for at least the following reasons.

Claim 25, upon which claim 37 is dependent, recites an apparatus that includes a controller configured to perform various operations. The operations include determining that a first network element in a communications network is out of service by sending a request to the first network element from the apparatus and determining that no response has been received from the first network element at the apparatus. Other operations include, when the first network element is determined to be out of service, drop a bearer configured to signal between the apparatus and a communications network comprising the first network element. Further operations include to discover or select at the apparatus a second network element, and to send from the apparatus to the second network element a message comprising an initial request for registration at the communications network.

Claim 26, upon which claim 38 is dependent, recites a method, including sending from user equipment a first message to a first network element, detecting at the user equipment that the first network element is out of service, and dropping a signalling bearer from the user equipment to a communications network comprising the user equipment and the first network element. The method also includes selecting or discovering at the user equipment a second

network element in the communications network, and sending from the user equipment to the second network element a message comprising an initial registration request.

Claim 43 recites an apparatus, including determining means for determining that a first network element in a communications network is out of service by sending a request from the apparatus to the first network element and determining that no response has been received from the first network element at the apparatus. The apparatus also includes, when the first network element is determined to be out of service, dropping means for dropping a bearer for signaling between the apparatus and a communications network comprising the first network element. The apparatus includes discovering means for discovering or selecting at the apparatus a second network element, and sending means for sending from the apparatus to the second network element a message comprising an initial request for registration at the communications network.

Claim 45 recites a computer readable medium configured to store instructions of a computer program that when executed controls a controller to perform sending from user equipment a first message to a first network element, detecting at the user equipment that the first network element is out of service, and dropping a signalling bearer from the user equipment to a communications network comprising the user equipment and the first network element. The computer readable medium is also configured to store instructions of a computer program that when executed controls the controller to perform selecting or discovering at the user equipment a second network element in the communications network, and sending from the user equipment to the second network element a message comprising an initial registration request.

The disclosure of Phan-Anh fails to disclose or suggest all of the elements of the claims, and therefore fails to provide at least the features discussed above.

Phan-Anh describes a method for a communication system in which a user can be provided with at least one registration at a first control entity. The one registration is transferred to a

second control entity in response to another registration of the user to the second control entity. In operation, the user equipment requests a registration by sending a SIP REGISTER message to a proxy server entity. The request is forwarded to an interrogating server and a subscriber database HSS. The interrogating server audits the first and second control entities for the user information and determines where the user IDs are registered. The interrogating server 31 then requests that the user be registered with the second control entity 23 and acknowledgements are also exchanged to confirm the registration process (see page 11, lines 10-30 of Phan-Anh).

In particular Phan-Anh discloses a network element (I-CSCF) which on being made aware that a S-CSCF is out of service, selects a new S-CSCF for registration of the user.

Phan-Anh fails to disclose that the user equipment is involved in the reselection or discovery of a second network element (e.g. the second SCSCF, 23). In contrast, independent claim 26 recites, in part, "detecting at the user equipment that the first network element is out of order". The Office Action refers to page 4, lines 25 to 30, and to page 14, lines 16 to 28, of Phan-Anh as purportedly describing this subject matter.. However, Applicants respectfully submit that the description of Phan-Anh is limited to providing that "another S-CSCF must be assigned e.g. by an ICSCF" (page 4, line 28) and "the I-CSCF is forced to select a new controller entity SCSCF2" (page 14, line 24 to 25). It is clear that the I-CSCF detects that the network element (e.g., the S-CSCF 23) is out of order, not the user equipment as recited in independent claim 26.

Furthermore, independent claim 26 recites, in part, "selecting or discovering at the user equipment... ". To reject this feature of independent claim 26 the Examiner refers to page 4, line 29 and page 14, line 24 to 25, of Phan-Anh. However, it is respectfully submitted that, in the referred portions, Phan-Anh merely describes that the I-CSCF selects the new S-CSCF. As mentioned above, the I-CSCF is not the user equipment.

In addition, independent claim 26 recites, in part, "sending from the user equipment to the

second network element a message comprising an initial registration request". To reject this feature of independent claim 26 the Examiner refers to page 6, lines 21 to 23, of Phan-Anh. However, this portion of Phan-Anh describes only that "said other registration may comprise as new registration of an identifier of the user or a re-registration of an identifier of the user". It is respectfully submitted that the "other registration" which this portion of Phan-Anh refers to is the "another registration of the user to said second control entity" as disclose at the top of the same page (page 6, lines 6, 7). In contrast and as previously mentioned, the selection of the second controller entity (S-CSCF2, 23) is selected by the I-CSCF - i.e., a network element and not user equipment as recited in independent claim 26.

Furthermore, in the Advisory Action mailed on 07/16/2009 the Examiner states that Phan-Anh teaches that a "new bearer must be established or the subscriber must be re-allocated to a another S-CSCF" in event of a failure, and refers to page 4, line 23 through col. 5, line 4. The Examiner's statement is disagreed with. The word "bearer" does not appear in Phan-Anh and, as a result, Phan-Anh does not teach that a "new bearer must be established".

The Applicants submit that Phan-Anh fails to teach all of the subject matter of independent claims 25, 26, 43, and 45 and related dependent claims. Withdrawal of the rejection of the claims under 35 USC 102(b) is requested, as Phan-Anh clearly fails to teach all elements of these independent claims and, thus cannot be said to anticipate these claims under 35 USC 102(b).

Claims 1, 3-15, 17, 19, 21-24, 34, 39-42 and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Phan-Anh (WO 02/091785) in view of 3GPP (3rd Generation Partnership Project; Technical Specification Group Service and System Aspects; Telecommunications Management; Charging Management; Charging data description for the IP Multimedia Subsystem (Release 5) 3GPP TS 32.225 v2.0.0 (2002-09), hereafter referred to as 3GPP). The Examiner takes the position that Phan-Anh discloses all of the elements of the claims, with the exception of determining at the first network element a type of the first

message, in dependence on the type of the first message, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service. The Examiner then cites 3GPP as allegedly curing this deficiency in Phan-Anh. This rejection is respectfully traversed for at least the following reasons.

Claim 1, upon which claims 3-18 are dependent, recites a method that includes receiving at a first network element in a communications network a first message from a user equipment, and transmitting the first message from the first network element to a serving network element. The method also includes detecting at the first network element that the serving network element is out of service, determining at the first network element a type of the first message, and in dependence on the type of the first message, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service. The method further includes subsequent to sending the error message to the user equipment, receiving a second message from the user equipment of a second type different from the first message type.

In rejecting claim 1 the Examiner states that 3GPP discloses determining at the first network element the type of the first message, and refers to page 18, section 2, stating that the "SIP request" is acknowledged by the "SIP response". Further, when rejecting claim 12 the Examiner refers to the same portion of 3GPP.

It is respectfully submitted that in actuality 3GPP does not disclose "in dependence on the type of the first message, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service". Instead, in 3GPP in the case of a failure the error message is sent from the P-CSCF (the first network element) to the user equipment regardless of the type of SIP Request (first message) that it receives from the user equipment.

Claim 1 has been amended to include certain subject matter found in claim 12 (which has

been cancelled without prejudice or disclaimer). As now even further clarified above claim 1 now recites in part:

"determining at the first network element a type of the first message, wherein determining the type of the first message comprises evaluating content of a predefined information element in the first message;
in dependence on the determined type of the first message, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service."


Clearly, claim 1 as now presented is not suggested by or rendered unpatentable by the proposed combination of Phan-Anh and 3GPP. As was noted, in 3GPP in the case of a failure the error message is sent from the first network element to the user equipment regardless of the type of SIP Request (first message) that it receives from the user equipment. In that claim 1 is allowable, then for at least this reason all claims that depend from claim 1 should also be found to be allowable, including claims 16 and 18 that were rejected under 35 USC 103(a) as allegedly being unpatentable over Phan-Anh in view of 3GPP, and further in view of the commonly owned U.S. Patent Appln. Pub. No. 2004/0225878 of Costa-Requena et al. (which was removed as a reference in the prior response). Further, the dependencies of claims 16-18 has been changed to depend now from the amended claim 1.

A similar clarifying amendment has been made to the independent claims 19, 34, 41 and 44, which should all also be found to be in condition for allowance. In that claims 19, 34, 41 and 44 are each allowable, then for at least this reason all claims that depend from claims 19, 34, 41 and 44 should also be found to be allowable.

The Examiner is respectfully requested to reconsider and remove the rejections of the claims under 35 U.S.C. 102(b) and 103(a), and to allow all of the pending claims as now presented for examination. An early notification of the allowability of all of the pending claims is earnestly solicited.

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